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AUG 15 2006

OFFICE OF PETITIONS

In re Application of :
Goldenberg, Hansen, and Leung : DECISION REFUSING STATUS
Application No. 10/672,278 : UNDER 37 CFR 1.47(a)
Filed: 29 September, 2003 :
Atty Docket No. 40923-0134US1 :

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 11 May, 2005.

The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION. Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 29 September, 2003, without an executed oath or declaration. Accordingly, on 22 December, 2003, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring the statutory basic filing fee, additional claim fees, an executed oath or declaration, a surcharge for their late filing, replacement drawings in compliance with 37 CFR 1.84 and 1.121, and sequence listing in compliance with 37 CFR 1.821-1.825. In response, on 21 May, 2004, petitioners filed a three

month extension of time, accompanied by replacement drawings, a corrected sequence listing, the statutory basic filing fee and additional claim fees, and surcharge and a declaration naming David M. Goldenberg, Hans J. Hansen, and Shui-on Leung as joint inventors and signed by joint inventors Goldenberg and Hansen on behalf of themselves and joint inventor Leung.

Accordingly, on 9 July, 2004, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring the signature of joint inventor Leung on the declaration. In response, on 9 February, 2005, petitioners filed a five (5) month extension of time, petition, and petition fee.

The petition was dismissed on 15 March, 2005, for failure to provide the residence of the inventors on the declaration. A new declaration listing the residence, citizenship, and mailing address of all of the inventors, signed by the signing inventors on behalf of themselves and the non-signing inventors was required.

The present renewed petition is accompanied by a declaration listing the residence, citizenship, and mailing address of all of the inventors, signed by joint inventor Hansen.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

- (3) the petition fee;

- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (2). The declaration filed with the renewed petition on 11 May, 2005, is defective in that it has not been signed by **all** of the signing inventors on behalf of themselves and the non-signing inventor. Specifically, previously signing inventor Goldenberg must sign the supplemental declaration on behalf of himself and non-signing joint inventor Leung.

The revocation and power of attorney filed on 24 April, 2006, cannot be accepted because the assignment document listed on the statement under 37 CFR 3.73(b), Reel 017429, Frame 0147, does not list all of the assignors (inventors). Rather, it is simply a copy of an employment agreement signed by non-signing inventor Leung.

MPEP 402.07 states, in pertinent part:

In an application that has been accorded status under 37 CFR 1.47(a), or for which status under 37 CFR 1.47(a) has been requested, a power of attorney given by the inventors who have signed the declaration (available inventors) may be revoked by an assignee of the entire interest of the available inventors (i.e., the applicant). See 37 CFR 1.32(b)(4). Rights of the assignee to take action may be established as provided in 37 CFR 3.73(b) and MPEP § 324.

As such, upon the granting of a renewed petition under 37 CFR 1.47(a), a new power of attorney by the inventors or applicant should be submitted.

A copy of this decision is being forwarded to the address listed in the paper filed on 24 April, 2006. All future correspondence will be sent solely to the address of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

A handwritten signature in black ink, appearing to read "D. Wood", is positioned above the printed name.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

cc: FAEGRE & BENSON LLP
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